

REMARKS

In the Office Action mailed on June 3, 2005 the Examiner made a statutory double patenting rejection of claims 21-44, which are all of the pending claims in this continuation application, over U.S. 6,299,996 (the "parent application"). Applicants respectfully traverse this rejection.

MPEP §804(II)(A) states the following (underlining and bolding added):

In determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice? 35 U.S.C. 101 prevents two patents from issuing on the same invention. "Same invention" means **identical subject matter**. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1984); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

It is noted that independent claims 21 and 33 of the present disclosure are apparatus claims, while independent claims 1, 17, and 27 of the parent application are method claims. This fact alone militates against a finding of statutory double patenting over independent claims 1, 17, and 27 of the parent application, as a method claim and an apparatus claim by definition do not claim identical subject matter.


Independent claim 9 (an apparatus claim) of the parent application recites in part "the stored information comprising an ordered list of frequency bands, each frequency band comprising at least one frequency channel, ***the stored information further comprising an identity of a band wherein an acceptable control channel was last located***" and "***collecting signal strength measurements on frequency channels in the frequency band to be searched***". Neither independent claim 21 nor independent claim 33 of the present disclosure recite the italicized subject matter. Thus, claims 21 and 33 do not claim identical subject matter to independent claim 9 of the parent application.

For at least these reasons, the Applicants respectfully submit that independent claims 22 and 33 do not claim the same subject matter as the claims of the parent application. The statutory double patenting rejection should be withdrawn.

It should also be noted that in response to a nonstatutory double patenting rejection in a previous Office Action rejecting claims 21-44, a Terminal Disclaimer and fee were filed on 06/23/2004. The Terminal Disclaimer was signed by the attorney of record. In that the term of the instant patent application has already been terminally disclaimed (more than one year ago), the Examiner is respectfully requested to allow the presently pending claims, and to pass this application to issue without further undue delay.

Should there be any remaining, unresolved issue that would impede the allowance of all of the pending claims, the Examiner is respectfully invited to contact the undersigned attorney at any one of the numbers appearing below.

4


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8/26/05
Date

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CERTIFICATE OF MAILING

August 26, 2005
Date

John Bingham
Name of Person Making Deposit